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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/131,076	08/07/1998	DOUGLAS E. KLIGMAN	6149-29-U1	7303

570 7590 03/21/2003

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2005 MARKET STREET, SUITE 2200  
PHILADELPHIA, PA 19103-7013

EXAMINER

TRAN, SUSAN T 31

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 03/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/131,076

Applicant(s)

KLIGMAN ET AL.

Examiner

Susan Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11-14 and 20-22 is/are rejected.
- 7) ☒ Claim(s) 7-10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Request for Extension of Time and Notice of Appeal filed 07/29/02, Request for Extension of Time, Request for Continued Examination, and Preliminary Amendment filed 01/07/03.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/07/03 has been entered.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blank WO 93/10756, in view of Damani et al. US 4,514,385.

Blank teaches a method for regulating wrinkles by topically applying to the skin a composition comprising of an effective amount of salicylic acid in ethanol solution

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(pages 2-4, and 6). The concentration of salicylic acid can range from 0.01% to 50% (see claim 2).

Blank is relied upon for the reasons stated above. The reference is silent as to the teaching of salicylic acid for the treatment of acne.

Damani teaches a composition comprising from about 0.1% to about 25% salicylic acid for the treatment of acne (column 2, lines 49 through column 3, lines 1-2). Thus, it would have been prima facie obvious for one of the ordinary skill in the art to modify Blank's composition for the treatment of skin acne in view of the teaching of Damani. The reason for this modification is to obtain a composition including up to 50% salicylic acid that is safe and useful for the treatment of skin wrinkles, acne, or other skin related conditions.

Claims 1-6, 11, 12, and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blank.

Blank is relied upon for the reason stated above. It would have been obvious that salicylic acid at a concentration of up to 50% is safe and useful for topical treatment of the skin.

### ***Response to Arguments***

Applicant's arguments filed 01/07/03 have been fully considered but they are not persuasive. The examiner maintains the original 103(a) rejections.

Applicant argues that neither Blank nor Damani teach or suggest the time sufficient to produce a chemical peel. Contrary to the applicant's argument, the time length recites in the claim is a mean sufficient to remove impurity from the skin. Blank recognizes the property required by applicant, *e.g.*, a skin cleaning composition comprising from about 0.1% to about 20% of salicylic acid (pages 10-11).

Applicant argues that both Blank and Damani teach persistent or chronic application of their compositions containing salicylic acid, while the present invention cannot be used as a persistent or chronic treatment because of the irritation. Contrary to the applicant's argument, it is noted that the feature upon which applicant relies (*i.e.*, cannot be used as a persistent or chronic treatment because of the irritation) is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, Blank also teaches the properties desired by the applicant, *e.g.*, pharmaceutical composition that is low toxic to render suitable for human, and possesses acceptable safety, including irritation and sensitization characteristics (pages 5-6).

Applicant argues that the function and properties are not inherent. However, the properties being claimed permit the removal of impurity from the epidermis, and Blank teaches a cleansing composition (pages 10-11). Applicant's specification page 10, paragraphs 1 and 2 allow wiping or washing to remove any residues or traces of the solution. This is the scope permitted and defined by applicant's specification for the term "chemical peel".

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Applicant argues that no where in Blank or Damani teach high amount of salicylic acid on the surface sufficient to produce chemical peel. However, the prior arts use sufficient range of salicylic acid permits by the applicant. No evidence of record indicated that amounts out side the range do not function effectively, hence, establishing at least 15% as being a minimum critical limitation.

### ***Conclusion***

This is a continued of applicant's earlier Application No. 09/131076. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Tran whose telephone number is (703) 306-5816. The examiner can normally be reached on Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
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